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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/043,856
Filing Date: January 11, 2002
Appellant(s): POUS ET AL.

MAILED

SEP 04 2007

GROUP 3600

Fred G. Pruner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 8, 2007 appealing from the Office action mailed December 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

However, while the statement of the current status of the claims is correct, the statement, "In an amendment filed by Applicant on February 6, 2007, Applicant requested the cancellation of claim 28," is not correct. Applicant requested the cancellation of claim 38, not 28.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,785,805	HOUSE et al.	8-2004
5,878,401	JOSEPH	3-1999
6,850,901	HUNTER et al.	2-2005

Anon., "EMCORE Announces Expectations for Record Year End Revenues and Substantial Increases in 2001 Backlog," Business Wire, p. 0144, October 30, 2000.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-55

Claims 42, 44, 45, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of the anonymous article, "EMCORE Announces Expectations for Record Year End Revenue and Substantial Increases in 2001 Backlog," hereinafter "EMCORE." As per claim 42, House discloses a method for providing custom-engineered products, the method comprising: providing an online catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale, in the sense of

not currently existing for sale (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through column 4, line 4; column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 36; column 10, lines 55-60; column 16, lines 14-27; column 29, lines 13-17). House does not disclose using selections of unavailable products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research to determine whether to extend a product offering that includes the unavailable products or attributes, but it is well known to use selections of unavailable products or attributes as market research to determine whether to extend a product offering that includes the unavailable products or attributes, as taught by "EMCORE" (two paragraphs beginning from "EMCORE will accelerate"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use the selections as market research to determine whether to extend a product offering, for the obvious advantage of profiting from offering a product for which there is demonstrated customer demand.

As per claim 44, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23).

As per claim 45, House discloses assigning a category of design requirements to the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29).

As per claim 53, House discloses that the unavailable product/attribute selector comprises a list of unavailable products/attributes (column 9, lines 30-36; column 13, lines 38-48).

As per claim 54, the existence and availability of at least one such list (as in claim 53, above) inherently requires at least one item to have been classified in the list.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 42 above and further in view of Joseph (U.S. Patent 5,878,401). House does not disclose suggesting an existing/standard product based upon and as a replacement for the selection, but Joseph teaches suggesting an existing/standard product based upon and as a replacement for the selection of an unavailable item (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantages of profiting from the sale of a recommended item, and saving the time needed to custom-manufacture an unavailable product.

Claims 46, 47, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 45 above and further in view of official notice. As per claim 46, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23). House does not disclose assigning a first category to the unavailable product attribute if the resource cost is relatively lower; and assigning a second category to the unavailable product attribute if the resource cost is relatively higher, but it is well known to assign categories to items based on cost. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to assign respective first and second categories based on lower or higher cost, for such

obvious advantages as assigning priority to engineer and manufacture a product, or track the results of a business practice, for possible modification.

As per claims 47 and 48, House discloses transmitting a request to a manufacturing facility for the product/attribute if is assigned to a first category (whatever that category may be) (column 7, lines 44-46), and official notice is taken that it is well known for transmissions to be transmissions to an appropriate address. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit a request for the unavailable product/attribute to an address with the assigned category, for the obvious advantage of causing appropriate action to be taken regarding the product/attribute; and to transmit the request to a manufacturing facility, for the obvious advantage of causing the product to be manufactured.

As per claim 49, House not expressly disclose the request to an engineering department for the unavailable product/attribute, but does disclose that an unavailable product/attribute may require engineering services, and that orders are sent to the appropriate personnel or department for engineering services (column 4, lines 12-27; column 4, line 59, through column 5, line 3; column 11, lines 6-21), and discloses transmitting information to a relevant department (column 7, lines 44-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the request to an engineering department if it is assigned to a second predefined category, for the obvious advantage of making the

information readily available to the engineering department to perform the necessary engineering.

Claims 50, 52, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 42 above and further in view of official notice. As per claim 50, House does not expressly disclose providing a list of available products in the online catalog, but official notice is taken that it is well known to provide lists of available products in online catalogs. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantage of profiting from the sale of products already available and in stock.

As per claim 52, House discloses transmitting a request to a manufacturing facility (column 7, lines 44-46). Whether this is for receiving an order for an available product depends on the meaning of "available," in that House's products are ordinarily not already sitting in inventory, but are in some cases available to be manufactured from available parts without significant testing or engineering (column 2, lines 35-44; column 4, lines 28-40), and are therefore available by Applicant's definition (the instant application, page 3, lines 1-4; page 6, line 6, through page 8, line 2); moreover, if "available" meant "already sitting on a shelf," transmitting a request to a manufacturing facility would be less necessary. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention of providing available products to would-be purchasers.

As per claim 55, House does not expressly disclose that the unavailable product/attribute selector comprises an online form (although House's disclosure regarding lists, menus, etc. could be read as implying an online form), but official notice is taken that it is well known to make catalog selections, etc., from an online form. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the unavailable product/attribute selector to comprise an online form, for the obvious advantage of enabling users to make selections in a standard manner likely to be familiar to users and to interface designers.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805), "EMCORE," and official notice as applied to claim 50 above and further in view of Hunter et al. (U.S. Patent 6,850,901). House does not disclose obsoleting an available product by moving it from the list of available products to a list of unavailable products, but Hunter teaches updating the status of products from available to unavailable (column 9, lines 25-41), which may be in an online catalog (column 6, lines 5-12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to obsolete an available product by moving it from the list of available products to a list of unavailable products, for the obvious advantage of informing shoppers which products are readily available, and which would require delay or custom manufacture, and profiting from resulting sales.

Claims 56-62

Claims 56, 57, 58, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of the anonymous article, "EMCORE Announces Expectations for Record Year End Revenue and Substantial Increases in 2001 Backlog," hereinafter "EMCORE." As per claim 56, House discloses a server which performs processing (column 11, line 56, through column 12, line 5); and a user interface selection device in communication with said processor (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through column 4, line 4; column 9, lines 14-36; column 10, lines 55-60) to select products or attribute which that are not currently offered in a line of available products or attributes from a provider (ibid.; see also column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 16, lines 14-27; column 29, lines 13-17). House does not quite expressly disclose that the user interface selection device is adapted to display a list of products or attributes at are not currently offered in a line of available products or attributes, but House discloses a list of selectable features and/or components (column 9, lines 30-36), making display of such a list obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling users to conveniently select such products or attributes.

House does not disclose the processor compiling selections of the available products to be used as market research for a decision of whether to extend a product offering to include the list of products or attributes, but it is well known for selections of products to be used as market research to determine whether to extend a product

offering to include the products or attributes, as taught by "EMCORE" (two paragraphs beginning from "EMCORE will accelerate"), and being aware of multiple requests, as taught in "EMCORE," implies compiling them. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the processor to compile selections of the available products to be used as market research to determine whether to extend a product offering to include the products or attributes, for the obvious advantage of profiting from offering products or attributes for which there is demonstrated customer demand.

As per claim 57, House discloses a list of unavailable products/attributes (*ibid.*, and especially: column 9, lines 30-36; column 13, lines 38-48), implying storing the data in a memory.

As per claim 58, House discloses displaying unavailable products/attributes, as set forth in the rejection of claim 56 above, and displaying a list as such is obvious, also as set forth in the rejection of claim 56 above.

As per claim 59, House discloses categories of design requirements associated with the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29), implying storing the data in a memory.

Claims 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over House and "EMCORE" as applied to claim 56 above, and further in view of official notice. As per claim 60, House discloses receiving a selection of an unavailable product/attribute (column 4, lines 12-27; column 10, lines 55-60); determining a resource cost for the unavailable product/attribute, and displaying a cost to the user

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(column 4, lines 15-23; column 10, lines 41-67). Official notice is taken that it is well known to display information on visual interfaces of computer systems; given House's disclosure of a computer system, displaying the cost on a visual interface thereof would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of conveniently making the information available to users.

As per claim 62, House discloses generating a specification for a product in response to receiving a selection from the user interface selection device of an unavailable product/attribute device (column 4, lines 12-27; column 10, lines 55-60; see also the section of the House patent applied in rejecting claim 56 for further documentation of unavailability). Official notice is taken that it is well know for computer systems to have CPU's which receive and process data; given House's disclosure of a computer system, receiving a selection and generating the specification by a CPU would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling the method to be carried out using standard computer hardware.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over House and "EMCORE" as applied to claim 56 above, and further in view of Joseph (U.S. Patent 5,878,401) and official notice. House discloses receiving a selection of an unavailable product/attribute via a selection signal from a user, and therefore from a user interface device (column 4, lines 12-27; column 10, lines 55-60; see also the section of the House patent applied in rejecting claim 56 for further documentation of

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unavailability). House does not disclose identifying one or more available products from the list of available products that has similar characteristics to those of the selected unavailable product/attribute, but Joseph teaches suggesting and an existing/standard product based upon and as a replacement for the selection of an unavailable item (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantages of profiting from the sale of a recommended item, and saving the time needed to custom-manufacture an unavailable product.

Official notice is taken that CPU's are well known, and using a CPU is held to be obvious as set forth in the rejection of claim 62 above.

(10) Response to Argument

Contrary to Appellant's arguments, the House patent and the "EMCORE" article combine to teach all limitations of the independent claims, and render the claims as a whole obvious. House discloses a method of providing custom-engineered products, by which customers can select unavailable products from an online catalog; that is, products which are not available on the shelf may be custom-manufactured and engineered in accordance with a customer's request. "EMCORE" teaches expanding a program to meet customer requests for a transponder product, and quotes Reuben Richards, the President and CEO of EMCORE, as saying that the decision to accelerate R&D investments in wireless and fiber optics was made in direct response to customer

demand, and further as saying, "Based on customer feedback ... we have accelerated our new product efforts and production capabilities."

It is true, as Appellant argues, that "EMCORE" does not teach obtaining customer requests for a new product via customer interaction with an online catalog, or via product selections that are made using a product selector of an online catalog. Examiner maintains, however, that this is not sufficient reason to allow the claims. If "EMCORE" taught such a means of obtaining customer requests, it would apparently anticipate at least claim 42, and the patent law does not require that a claim be anticipated to be validly rejected. The question in this case is whether the combination of references renders the claims obvious.

Examiner maintains that given the unavailable product selector disclosed by House, and the practice of expanding R&D efforts and accelerating new product efforts to make a product shown to be in demand from customer requests and feedback, as taught in House, it would have been obvious to one of ordinary skill in the art to use selections of unavailable products to determine whether to extend a product offering that includes the unavailable products or attributes, as recited in claim 42.

There is a clear motivation of profiting from producing what customers demand, and it is known to conduct market research in various ways to determine what customers want, making the use of customer requests and feedback obtained in a particular way obvious, provided that that particular way is itself known, and House discloses the particular way in question. The "EMCORE" article teaches a motivation to use customer requests and feedback, quoting Mr. Richards as saying that, based in part

on customer feedback, “[W]e have accelerated our new product efforts and production capabilities to shorten time to market and achieve the long-term results our customers and shareholders expect of EMCORE.” He goes on to say, “Additionally, given our strong backlog numbers, and the projected revenue from our new products, we will raise revenue estimates for fiscal 2001.” In short, responding to customer requests and feedback to produce new products desired by customers is expected to lead to business success and increased revenues.

Appellant criticizes Examiner’s reference to *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), saying that in that case the Federal Circuit held that the examiner had failed to establish a *prima facie* case of obviousness for the reason that the examiner failed to show where the prior art taught or suggested all limitations. Examiner replies that he referred to *In re Fine* for the doctrine that there must be some teaching, suggestion, or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the references to produce the claimed invention. In this case, there is no question of the prior art failing to teach or suggest all the limitations (of claim 42 in particular); House and “EMCORE” between them have all of the limitations, and the question is one of obviousness to combine.

The Supreme Court’s more recent decision in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) is relevant for at least two reasons. First, the Court decided, “[I]f there is design need or market pressure to solve problem, and there are finite number of identified, predictable solutions, person of ordinary skill in the art has good reason to pursue known options within his or her technical grasp, and if this leads

to anticipated success, it is likely product of ordinary skill and common sense, not innovation." (1386). "EMCORE" clearly teaches design need or market pressure to solve the problem of learning what customers want to buy that is not currently available, so as to determine whether to extend a product offering that includes the unavailable products or attributes (not that EMCORE's Mr. Richards seems to have regarded it as a difficult problem), and receiving requests for unavailable products from an online catalog is disclosed by House as an identified, predictable solution. Combining the two would not require extraordinary technical skill, and would lead to anticipated success. Therefore, we should conclude that the combination is likely the product of ordinary skill and common sense, not patentable innovation.

Secondly, and relatedly, the Court noted in *KSR*, "[I]t is error to apply the TSM test as rigid and mandatory formula that limits obviousness analysis through formalistic conception of words 'teaching,' 'suggestion,' and 'motivation,' or by overemphasis on importance of published articles and explicit content of issued patents, since market demand, rather than scientific literature, often drives design trends, and granting patent protection to advances that would occur 'in the ordinary course' without real innovation retards progress and may, in case of patents combining previously known elements, deprive prior inventions of their value or utility." (1385-1386). Examiner has no need to invoke the Court's disapproval of overemphasis on the importance of published articles and explicit content of issued patents, since a published article and an issued patent do teach all the elements of claim 42 between them. Examiner does wish to note, however, the Court's recognition of the importance of market demand in driving design

trends, and submits that this is further reason to conclude that it would have been obvious to utilize information on market demand gathered from the unavailable product/attribute selector of an online catalog to aid in determining whether to extend a product offering.

Claim 56 is largely parallel to claim 42, but being a system claim, is phrased somewhat differently. Appellant argues that neither House nor "EMCORE" teaches or suggests a processor to compile the selections, to which Examiner replies that, as set forth in the rejection above, House discloses a server which performs processing, and "EMCORE" teaches being aware of plural customer requests. Responding to "customer demand" and "customer feedback" implies keeping track of whether one customer requests a transponder product, or a couple of customers do, or dozens. One could plausibly project much more revenue from new products if many customers had requested them than if one or a few customers had done so. Compiling selections of unavailable products is therefore implied by "EMCORE," and using a processor to do so by the computerized system of House. Making the combination is held to be an instance of a "person of ordinary skill in the art ha[ving] good reason to pursue known options within his or her technical grasp," as the Court put it in KSR, and should be considered the "product of ordinary skill and common sense, not innovation." Appellant, after all, makes no claim to being the inventor of using processors to compile data.

Thus, the independent claims recite nothing that would not have been obvious to a person of ordinary skill in the art familiar with House and "EMCORE," and the dependent claim (concerning which Appellant makes no separate arguments) are also

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validly rejected based on the prior art of record, and on well-known facts of which untraversed official notice was taken. Examiner therefore respectfully requests that the rejections should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nicholas D. Rosen

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